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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,758	04/11/2001	William M. Jackson	82515RLO	3362

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11/04/2004

Thomas H. Close
Eastman Kodak Company
Patent Legal Staff
343 State Street
Rochester, NY 14650-2201

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,758

Applicant(s)

JACKSON ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/11/01, 10/1/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2,6-9,13 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (U.S. patent 6,618,051) in view of Safai et al (U.S. patent 6,167,469)

Regarding claim 1,8 and 22 alter Edwards et al disclose: A method of ordering a photo product to be printed at a selected location and delivered to a designee comprising the steps of: (a) a user communicating with a service provider that offers a plurality of photo products and selecting a particular photo product to incorporate a digital image provided by the user (please note Edwards et al column 5 lines 1-8, also Fig.8 column 9 lines 29-42). However Edwards et al do not disclose: (b) the user providing an identification of the designee's location where the selected photo product is to be delivered (c) the service provider automatically selecting from a plurality of printing locations a particular printing location based on the identification of the designee's location (d) using a communications network to transfer the digital image from the user to the particular printing location and (e) printing the selected photo product at the particular printing location and delivering the photo product to the designee. On the other hand Safai et al disclose: (b) the user providing an identification of the designee's location where the selected photo product is to be delivered (please note Safai et al

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column 14 lines 35-44) (c) the service provider automatically selecting from a plurality of printing locations a particular printing location based on the identification of the designee's location (please note, column 14 lines 29-35 where the photos are sent the print job to the high resolution color printer) (d) using a communications network to transfer the digital image from the user to the particular printing location (please note column 14 lines 32-35) and (e) printing the selected photo product at the particular printing location and delivering the photo product to the designee (please note column 14 lines 35-44).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Edwards et al's invention according to the teaching of Safai et al, where Safai et al in the same filed of endeavor teach the way the addresses of the recipients or designees is added to the photos through the service provider for the purpose of being able to deliver the photos to the designee at different locations.

Regarding claim 2 and 9 Safai et al disclose: The method of claim 1 wherein the user makes payment via the network for the photo product (please note column 15 lines 19-26).

Regarding claim 6 Safai et al disclose: The method of claim 5 wherein the user transfers the digital image to the network address communicated by the service provider (please note column 14 lines 30-45).

Regarding claim 7 and 13 Safai et al disclose: The method of claim 1 wherein the photo product includes at least one album page (please note column 15 lines 27-30) the digital image is transferred from the user directly to the particular printing locations and

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album page background image data is communicated from the service provider to the particular printing location in order to produce the at least one album page (please note column 15 lines 31-45).

Regarding claim 23 Safai et al disclose: The method of claim 22 wherein step (f) includes printing a postage stamp on the shipping label (please note column 14 lines 38-42).

Regarding claim 24 Safai et al disclose: The method of claim 23 wherein the postage stamp depicts at least a portion of the digital image (please note column 14 lines 35-44).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3-5,10-12 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (U.S. patent 6,618,051) in view of Safai et al (U.S. patent 6,167,469) and further in view of Kanevsky et al (U.S. patent 6,285,777)

Regarding claim 3,10 and 25 Neither Safai et al nor Edward et al disclose: The method of claim 1 wherein the identification of the designee's location is the designee's zip code. On the other hand Kanevsky et al disclose: The method of claim 1 wherein the

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identification of the designee's location is the designee's zip code (please note column 3 lines 27-34 where the designee or recipient zip code is specified for addressing)

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al and Edwards et al's invention according to the teaching of Kanevsky et al, where Kanevsky et al in the same filed of endeavor teach the way the addresses of the recipients is converted in terms of their Zip codes for the purpose of making the delivery more accurate.

Regarding claim 4 and 26 and Kanevsky et al disclose: The method of claim 3 wherein the photo product is delivered to the designee by the U.S. postal service (please note column 3 lines 28-32).

Regarding claim 5 and 12 Kanevsky et al disclose: The method of claim 1 wherein the service provider communicates a network address of the particular printing location to the user (please note column 3 lines 1-40).

Regarding claim 11 Kanevsky et al disclose: The method of claim 10 wherein the postal code is a zip code (please note column 3 lines 27-34 where the designee or recipient zip code is specified for addressing).

5. Claim 14-21 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al (U.S. patent 6,618,051) in view of Safai et al (U.S. patent 6,167,469) and further in view of Kanevsky et al (U.S. patent 6,285,777)

Regarding claim 14,18 and 27 Edwards et al disclose: A method of ordering a photo product to be printed at a selected location and delivered to a designee,

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comprising the steps of: (a) a user communicating with a service provider that offers a plurality of photo products and selecting a particular photo product to incorporate a plurality of digital images provided by the user (please note column 5 lines 1-8, also Fig.8 column 9 lines 29-42) (b) the service provider producing a representation of the photo product and sending such representation to the user (please note column 1 lines 37-44) (c) the user approving an order for the photo product depicted in said representation (please note column 10 lines 7-13). However Edwards et al do not quite disclose: and providing an identification of the designee's location where the selected photo product is to be delivered;; and providing an identification of the designee's location where the selected photo product is to be delivered (d) the service provider using said identification of the designee's location to select from a plurality of printing locations a particular printing location On the other hand Safai et al disclose: providing an identification of the designee's location where the selected photo product is to be delivered;; and providing an identification of the designee's location where the selected photo product is to be delivered (please note column 14 lines 29-45) (d) the service provider using said identification of the designee's location to select from a plurality of printing locations a particular printing location (please note column 2 lines 1-14). However neither Edwards et al nor Safai et al disclose: (e) using a communications network to transfer the plurality of digital images to the particular printing location; and (f) printing the selected photo product at the particular printing location and delivering the photo product to the designee. On the other hand Kanevsky et al disclose: (e) using a communications network to transfer the plurality of digital images to the particular

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printing location (please note column 3 lines 34-51) and (f) printing the selected photo product at the particular printing location and delivering the photo product to the designee (please note column 3 lines 7-34).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Safai et al and Edwards et al's invention according to the teaching of Kanevsky et al, where Kanevsky et al in the same filed of endeavor teach the way the addresses of the recipients is converted in terms of their Zip codes for the purpose of making the delivery more accurate.

Regarding claim 15 Safai et al disclose: The method of claim 14 wherein the plurality of photo products is selected from a group including an album page containing two or more digital images provided by the user (please note column 15 lines 27-35).

Regarding claim 16 Safai et al disclose: The method of claim 14 wherein the plurality of photo products includes prints having a plurality of different sizes (please note column 10 lines 32-35).

Regarding claim 17 Safai et al disclose: The method of claim 14 further including the steps of a user providing a payment identifier specifying an account to be charged for producing and delivering the photo product (please note column 15 lines 16-25).

Regarding claim 19 Safai et al disclose: The method of claim 18 wherein the suitable time is a time selected by the user (please note column 15 lines 40-43).

Regarding claim 20 Safai et al disclose: The method of claim 18 wherein the suitable time is a time selected for efficient transfer over the channel (please note column 15 lines 30-45).

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Regarding claim 21 Safai et al disclose: The method of claim 18 wherein the suitable time is selected by a user from a plurality of service times provided by the provider (please note column 15 lines 40-43).

Regarding claim 28 Kanevsky et al disclose: The method of claim 27 wherein the user makes payment via the network for the hard copy product (please note column 15 lines 19-26).

Regarding claim 29 Kanevsky et al disclose: The method of claim 27 wherein the identification of the designee's location is the designee's zip code (please note column 3 lines 27-34 where the designee or recipient zip code is specified for addressing)

Regarding claim 30 Kanevsky et al disclose: The method of claim 29 wherein the hard copy product is delivered to the designee by the U.S. postal service (please note column 3 lines 28-32).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

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Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark

"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

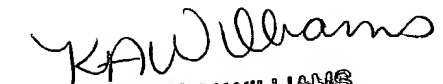
Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

October 25 2004


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER